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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,836	03/22/2003	Kenneth Deaton	368-1104U	8985
23429	7590	08/10/2006	EXAMINER THERIAULT, STEVEN B	
GREGORY SMITH & ASSOCIATES 3900 NEWPARK MALL ROAD, 3RD FLOOR NEWARK, CA 94560			ART UNIT 2179	PAPER NUMBER

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/625,836	DEATON ET AL.	
	Examiner	Art Unit	
	Steven B. Theriault	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 26-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the following communications: Non-Provisional application filed 07/22/03 with an Information Disclosure statement filed 9/29/2003.
2. Claims 1-25 are pending in the case. Claims 1, 14, 17, 23, and 26 are the independent claims. Claims 26-34 are non-elected and the cancelled claims.

Specification

3. The attempt to incorporate subject matter into this application by reference to U.S. patents in the US References section of the specification is ineffective because 37 CFR 1.57(b) states that, an incorporation by reference must be set forth in the specification and express an clear intent to incorporate by reference by using the root words "incorporate" and "reference". If the applicant did not intend to incorporate by reference, then the references section of the specification is reserved for pending applications or patents by the applicant that are to be incorporated by reference and therefore the list of patents currently shown in the specification should be listed on form SB/08 if they are to be considered as relevant or prior art to the present application and should be considered by the examiner during examination.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-25 are drawn to a system with a specific display space that allows a user to assign attributes to files and arranging files on the display, classified in class 715, subclass 765.
 - II. Claims 36-34 are drawn to a method for assigning XML information to files through the use of a newly opened XML editor and entering in specific XML tags for each file and

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then correspondingly sorting and filtering the files based on the XML tag information, classified in class 715, subclass 763.

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case,

Invention I is separately usable as indicated in the use that is expressly recited in the claims – a system for arranging files based on personal attributes. That is, the interface comprises a display space that allows the user to arrange files based on personal preferences. Invention I fails to recite any limitations regarding: 1) opening an XML editor to perform an operation on the files 2) creating and assigning XML tags to the files 3) sorting the newly assigned files based on filters or the created tags and then displaying the sorted files. Invention I can be implemented in a variety of windows, HTML or Unix file managers commonly known in the art that allow for content on a machine to be organized by a user of the system.

Invention II is separately usable as indicated in the uses that are expressly recited in the claims – a method for opening an XML editor, entering in XML information for each file and then sorting or filtering the files based on the XML tags and then displaying the result. Invention II fails to recite any limitations regarding: 1) personal attributes; or 2) assigning the personal attributes to files.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction

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requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

During a telephone conversation with Carol Titus on 08/04/2006 a provisional election was made with traverse to prosecute the invention of claims 1-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 26-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Claim Rejections - 35 USC § 102

5. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-19, 22-25 are rejected under 35 USC 102(e) as being anticipated by Gilbert et al. (hereinafter Gilbert) U.S. Patent No. 6,370,537 issued Apr. 9, 2002 and filed Dec. 30, 1999.**

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In regard to **Independent claim 1**, Gilbert teaches a display system for a computer system, comprising:

- A computer system having a plurality of electronic files stored therein, a plurality of personalizable attributes assignable to each of said plurality of electronic files, (Gilbert Figure 4 and 16 and column 12, lines 50-67 and column 13, lines 1-20). Gilbert teaches the user can enter or create Meta objects that represent information categorized and displayed on the interface in a plurality of electronic files.
- A selection space capable of displaying the plurality of electronic files, wherein a user may arrange the electronic files within the selection space according to the personalizable attributes (Gilbert Figures 27-51) Gilbert teaches a space that displays the files and where the user can rearrange the files.

With respect to **dependent claim 2**, Gilbert teaches the display system wherein the selection space is a 3D representation (See column 7, lines 48-67).

With respect to **dependent claim 3**, Gilbert teaches the display system wherein the personalizable attributes are chosen from the group of attributes consisting of key words and classification information (Gilbert column 7, lines 1-67).

With respect to **dependent claim 4**, Gilbert teaches the display system wherein the selection space may be modified for viewing using a multiplicity of schemas (Gilbert column 7 lines 1-67 and 4a-e)

With respect to **dependent claim 5**, Gilbert teaches the display system wherein the personalizable attributes are assigned manually by the user (Gilbert column 7 lines 1-67 and 4a-e).

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With respect to **dependent claim 6**, Gilbert teaches the display system wherein the personalizable attributes are assigned automatically based on classification controls or attribute database characteristics (Gilbert column 7 lines 1-67 and 4a-e and column 9, Line 1 thru column 10, line 67).

With respect to **dependent claim 7**, Gilbert teaches the display system wherein the personalizable attributes include XML metatags (Gilbert column 7 lines 1-67 and 4a-e and column 9, Line 1 thru column 10, line 67).

With respect to **dependent claim 8**, Gilbert teaches the display system wherein the selection space contains viewable images representative of the underlying file content (Gilbert Figure 24).

With respect to **dependent claims 9-10**, Gilbert teaches the display system wherein the selection space has an appearance chosen from the group of schema consisting of a checkerboard, a bookstore, a music room, shelves, a virtual room, tree structures and cone trees and a cityscape (Gilbert figures 15-20).

With respect to **dependent claim 11**, Gilbert teaches the display system of claim 1, wherein a cursor of the computer system creates a visually magnified area of the selection space 9Gilber Figure 15 and 25).

With respect to **dependent claim 12**, Gilbert teaches the display device wherein said computer system is selected from the group of computer systems consisting of game consoles, set-top boxes, personal computers, plant floor manufacturing equipment and automated control system (Gilbert column 4, lines 31-67).

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With respect to **dependent claim 13**, Gilbert teaches the display device wherein said computer system is a mobile or wireless device (Gilbert column 4, lines 31-67).

In regard to **Independent claim 14**, Gilbert teaches a display system for a computer system, comprising:

A computer system having a plurality of electronic files stored therein, each of said plurality of electronic files having XML tags and an icon, and a customizable 3D desktop containing the icons associated with said plurality of electronic files, the icons arranged based on information in the XML tags, wherein a user may rearrange the icons (Gilbert column 3, lines 15-67 and column 12, lines 50-67 and column 13, lines 1-20) Gilbert teaches XML meta objects that comprises tags and icons that are displayed in figure 14 in a 3D desktop and the user can rearrange the icons and defines the layouts as shown in figures 27-51.

With respect to **dependent claim 15**, Gilbert teaches the display device further comprising a plurality of user input fields and wherein said 3D desktop may be arranged based information contained in said plurality of user input fields (Gilbert Figures 27-51) Gilbert shows the interface mechanisms for allowing the user to adjust the interface to user preference through input fields.

With respect to **dependent claim 16**, Gilbert teaches the display device of claim 14, wherein said user input fields create XML tags (Column 11, lines 6-67 and column 12, lines 1-10).

In regard to **Independent claim 17**, Gilbert teaches a display system for a computer system, comprising: a computer system having a plurality of electronic files stored therein, a plurality of automatically generated WYSIWYG icons representing said plurality of electronic files, said WYSIWYG icons being generated based on file characteristics, and a selection space

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capable of displaying the plurality of electronic files, wherein a user may arrange the electronic files within the selection space according to the personalizable attributes (Gilbert column 3, lines 15-67 and column 12, lines 50-67 and column 13, lines 1-20) Gilbert teaches XML meta objects that comprises tags and icons that are displayed in figure 14 in a 3D desktop and the user can rearrange the icons and defines the layouts as shown in figures 27-51. Gilbert shows the icons with the information displayed within them, which the examiner considers a WYSIWIG icon.

With respect to **dependent claim 18**, Gilbert teaches the display device wherein said file characteristics are selected from the group consisting of file size, date accessed, times accessed, and preferences (Gilbert column 15, lines 15-20).

With respect to **dependent claim 19**, Gilbert teaches the display device of claim 17, wherein said WYSIWYG icons have characteristics including size and color (Gilbert column 13, lines 35-45).

With respect to **dependent claim 22**, Gilbert teaches the display device wherein said WYSIWYG icon is formed of multiple icons (Gilbert column 15, lines 35-67).

In regard to **Independent claim 23**, Gilbert teaches a method of storing, sorting and accessing files on a computer system, the method comprising the steps of: (a) assigning a plurality of personalized attributes to an electronic file; (b) and accessing a selection space having a user defined schema (Gilbert column 3, lines 15-67 and column 12, lines 50-67 and column 13, lines 1-20) Gilbert teaches XML meta objects that comprises tags and icons that are displayed in figure 14 in a 3D desktop and the user can rearrange the icons and defines

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the layouts as shown in figures 27-51. Gilbert teaches the user directly selects the specific display representation for displaying data and layouts (See column 15, lines 15-20).

With respect to **dependent claim 24**, Gilbert teaches the method further, comprising the step of scanning the electronic file to create a content-representative icon (Gilbert figure 10 and 25 and column 12, lines 59-67 and column 13, lines 1-20) Gilbert teaches the user select the information for display within the icon.

With respect to **dependent claim 25**, Gilbert teaches the method of claim 23, further comprising the step of modifying the icon within the selection space (See column 13, lines 1-20 and figures 27-51).

It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re *Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re *Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

Claim Rejections - 35 USC § 103

7. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 20-21 are rejected under 35 USC 103(a) as being unpatentable over Gilbert et al. (hereinafter Gilbert) U.S. Patent No. 6,370,537 issued Apr. 9, 2002 and filed Dec. 30, 1999.**

With respect to **dependent claims 20-21**, as indicated in the above discussion, Gilbert teaches every element of claim 17.

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Gilbert does not expressly teach the display device wherein said WYSIWYG icon has a frequency of vibration or has a sound. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Gilbert, because Gilbert expressly teaches the ability of the user to select a variety of preferences such as colors and display backgrounds (See Gilbert column 13, lines 35-40). This would also suggest to one of ordinary skill in the art that Icons employing sounds and actions that are tactically felt by the user can be assigned as preferences because sounds and vibration characteristics are known in the common art as HTML preferences that a user can select.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Theriault whose telephone number is (571) 272-5867. The examiner can normally be reached on M-F 7:30 - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SBT


WEILUN LO
SUPERVISORY PATENT EXAMINER